

REMARKS

A Petition for Extension of Time is being concurrently filed with this Amendment. Thus, this Amendment is being timely filed (May 21, 2006, falls on a Sunday).

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

Status of the Claims

In the present Reply, claims 1 and 7 have been amended, and claims 16-18 have been added. Also, claims 12-15 stand withdrawn from consideration. Thus, claims 1-18 are pending in the present application.

No new matter has been added by way of these amendments and new claims, because each amendment and new claim is supported by the present specification. For example, the amendment to claim 1 can be found in original claim 7 as well as in the specification at page 128, lines 19-24 (which reads: "... a dispersion of composite polymer microparticles formed by polymerizing hydrophobic monomers in the presence of inorganic microparticles in a composition containing them"). Otherwise, the changes to claim 1 are merely editorial in nature. The amendment to claim 7 has support in the specification in Table 1, Sample Nos. 16-18 (page 200). New claim 16, drawn to a preferred embodiment of the present invention and has been added for the Examiner's consideration, has support in original claim 1 except adds the phrase "heating the layers-formed support at a temperature of 30 to 60°C." The recited range of heating temperature is found in the present specification at page 83, lines 19-20. With regard to newly

added claims 17 and 18, Applicants respectfully refer the Examiner to Sample Nos. 7-18 and 16-18, respectively, of Table 1 (page 200). Thus, no new matter has been added.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 102(b)

Claims 1-8 and 10-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sudo *et al.* '170 (U.S. Patent No. 5,424,170) (see paragraph I. of the outstanding Office Action). Sudo '170 is newly cited, as stated in paragraph III. of the Office Action. Applicants respectfully traverse this rejection.

First, Applicants initially refer the Examiner to pending claim 1 as presented herein. Second, Applicants respectfully submit that the cited Sudo '170 reference discloses silver halide photographic light-sensitive materials comprising a silver halide emulsion layer containing latex. However, none of the Sudo '170 latexes are formed via polymerization of hydrophobic organic monomers in the presence of inorganic microparticles as instantly claimed. Thus, Sudo '170 fails to disclose all instantly claimed features.

Applicants also note the Examples of Sudo '170 as lacking the instantly claimed feature. For instance, Sudo '170 uses a coating composition for a silver halide emulsion layer comprising a latex polymer of polyethylacrylate in its Example 1 (see the Table in column 60, 8th ingredient from the top). One of ordinary skill in the art would readily understand and recognize that the

latex is formed by simply polymerizing ethyl acrylate monomers. This same latex is also used in Example 2 in Sudo '170 (see column 64, stating at line 30), though no latex is used in Examples 3 and 4. Also, in Example 5, Sudo '170 has a "polymer latex 1" (at 1.0 g/m²) contained in a coating composition for silver halide emulsion layer (see column 74, line 3). But this "polymer latex 1" is formed by a simple polymerization of three kinds of organic monomers (see column 74, lines 3-4 from the bottom of Applicants' specification). Sudo '170 does disclose a "polymer latex 2" in Example 5, but this latex is located in the protective layer (see column 74, line 11 and column 74, last two lines). Finally, Example 6 uses "polymer latex 1," which is the simple polymerization of three kinds of organic monomers.

Accordingly, Applicants respectfully submit that Sudo '170 fails to disclose all claimed features, including "the silver halide emulsion layer contains a composite latex formed by polymerizing one or more hydrophobic organic monomers in the presence of inorganic microparticles." This deficiency in Sudo '170 is also apparent in reviewing its own Examples. Applicants further note that the term "latex" is not even described in any parts preceding the Example section of the Sudo '170 specification. Therefore, because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the cited Sudo '170 reference cannot be a basis for a rejection under § 102(b). *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Sudo '170 is overcome.

Applicants add the following remarks concerning "polymer latex 1" of Sudo '170 with respect to the present invention. In Example 5, Sudo '170 discloses that its "polymer latex 1" is

mixed with a colloidal silica to form the coating composition for a silver halide emulsion layer (see column 74, lines 3 and 5). However, the instantly claimed composite latex is not the same as this mixture of latex and inorganic particles. Instead, the claimed composition can produce a composite latex wherein the inorganic particles are homogenously and completely covered with the polymer latex. This particular structure cannot be produced by merely mixing the polymer latex with the inorganic particles. This is because the mixing of these materials would cause partial coagulation due to an interaction between the polymer latex and the inorganic particles. Applicants note that the composite latex of the presently claimed invention is free from such coagulation. Thus, Sudo '170 does not disclose the present invention, despite the disclosure at the top of column 74 regarding its Example 5.

Based on the above, Applicants respectfully submit that Sudo '170 fails to disclose all features as instantly claimed. Reconsideration and withdrawal of this rejection are respectfully requested.

Issues under 35 U.S.C. § 103(a)

Claims 4, 6 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sudo *et al.* '170 considered in view of Morishima *et al.* '040 (U.S. Patent No. 5,994,040) (see paragraph II. of the Office Action). Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested. Overall, Applicants do not concede that a *prima facie* case of obviousness has been established.

Each of claims 4, 6 and 9 depend on pending claim 1. Thus, Applicants' previous arguments apply to this rejection as well. In particular, the deficiency of Sudo '170 is noted

above (e.g., the claimed “the silver halide emulsion layer contains a composite latex formed by polymerizing one or more hydrophobic organic monomers in the presence of inorganic microparticles”). Further, such deficiency is not accounted for in the cited Morishima ‘040 reference since this secondary reference fails to disclose the claimed composite latex.

Morishima ‘040 does not disclose a latex formed by polymerizing one or more hydrophobic organic monomers in the presence of inorganic microparticles. In its working examples, Morishima ‘040 uses a coating composition for an emulsion layer comprising polyethyl acrylate latex or a mixture of polyethyl acrylate latex and latex copolymer in which the ratio of butyl acrylate/acrylic acid/2-acetoxyethyl methacrylate is 80/4/16 (see column 186, lines 30-32; column 190, lines 34-36; column 220, line 39; and column 228, lines 65-66). Accordingly, both of Sudo ‘170 and Morishima ‘040 fail to disclose all claimed features and this rejection under § 103(a) has been overcome. This is because U.S. case law squarely holds that a proper obviousness inquiry requires consideration of three factors, which includes the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *see also In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, by not disclosing all claimed features even when the cited references are combined, this rejection has been overcome.

Applicants add that the requisite motivation for a *prima facie* case of obviousness is lacking as well. *In re Vaeck; supra*. In this regard, Applicants respectfully refer the Examiner to the unexpected superiority of the present invention as achieved in the various inventive Samples in, e.g., Table 1, page 200 of Applicants’ specification.

Along the same lines, Applicants respectfully submit that the present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness (whether based on Sudo '170, Morishima '040 or any other reference or combinations thereof). See *In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985); see also *In re Papesch*, 315 F.2d 381, 137 USP 43 (CCPA 1963); *In re Wiechert*, 370 F.2d 927, 152 USPQ 247 (CCPA 1967). As stated in M.P.E.P. § 2144.09 (see section entitled "*Prima Facie* Case Rebuttable By Evidence of Superior or Unexpected Results"), any rejection under 35 U.S.C. § 103(a) may be rebutted by a sufficient showing of unexpected results for the present invention. Applicants respectfully refer the Examiner to the inventive Samples in the present specification (see Table 1 on page 200), wherein the present invention has unexpectedly superior properties over the comparative Samples. Thus, this showing of unexpected results rebuts any rejection based on 35 U.S.C. § 103(a).

Based on the above, reconsideration and withdrawal of this rejection are respectfully requested.

New Claims 16-18

Applicants also request favorable consideration of newly added claims 16-18. As mentioned, new claim 16 is similar to original claim 1 except adds the phrase "heating the layers-formed support at a temperature of 30 to 60°C." The recited range of heating temperature is found in the present specification at page 83, lines 19-20. Applicants note that neither Sudo '170 or Morishima '040 discloses all features of the new claims, especially with regard to the heating temperature as instantly recited. Applicants add that one of ordinary skill in the art

would not have predicted or recognized that heating at 30-60°C would improve the film strength before the claimed invention was made.

Conclusion


A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: Monday, May 22, 2006

Respectfully submitted,

By  Marc S. Weiner (Reg. No. 32,181)

Registration No.: 32,181

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant